Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MANABU INOUE,
HIROKAZU YAGURA,
TORU ISHII,
YUKARI MAEDA,
TETSUO YAMADA,
and
KATSUYUKI NANBA

_____

Appeal No. 1998-2540
Application No. 08/214,707

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ON BRIEF

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Before JERRY SMITH, FLEMING, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-5, 7-10, 12-14 and 16-21, which constitute all the claims remaining in the application. An amendment after final rejection was filed on

December 30, 1996, and was entered by the examiner.

The disclosed invention pertains to an electronic filing system for storing and retrieving information related to film records. More particularly, a film records both image information and separate photographic information relating to the image. The image information is sensed from the film while the corresponding photographic information is separately read from the film. The image information and the photographic information are then stored together on a recording medium. Images on the recording medium can then be retrieved by use of the corresponding photographic information.

Representative claim 18 is reproduced as follows:

18. An electronic filing system for filing a photographed image recorded on a film, wherein the film records photographic information relating to the image in addition to the photographed image, the filing system comprising:

image sensing means for sensing a photographed image recorded on the film;

reading means for reading the photographic information that is recorded on the film in addition to the photographed image;

a recording medium for recording a plurality of images and the photographic information; and

writing means for writing the image sensed by said image sensing means and the photographic information read by said reading means together on said recording medium.

The examiner relies on the following references:

Ueno et al. (Ueno)	4,777,537	Oct. 11, 1988
Blancato	4,823,285	Apr. 18, 1989
Takeuchi et al. (Takeuchi)	4,888,648	Dec. 19, 1989
Wash	4,974,096	Nov. 27, 1990

The following rejections are before us on appeal:

1. Claims 3-5, 7, 8, 10, 12-14 and 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Takeuchi in view of Wash.

2. Claims 9, 16, 17 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Takeuchi in view of Wash and further in view of Blancato.

3. Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Takeuchi in view of Wash and further in view of Ueno.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on

appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2-5, 7-10, 12-14 and 16-21. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467
(1966), and to provide a reason why one having ordinary skill

in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788

(Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered (see 37 CFR § 1.192(a)).

We consider first the rejection of claims 3-5, 7, 8, 10, 12-14 and 18-20 based on the teachings of Takeuchi and Wash. With respect to independent claim 18, the examiner finds that Takeuchi teaches the claimed invention except that Takeuchi fails to teach that both the image and the photographic information are produced from a photographed film. The examiner cites Wash as teaching apparatus which reads information from a film and supplies this information to a processing circuit for later use. The examiner concludes that it would have been obvious to the artisan to modify the device of Takeuchi with sensing and reading means as taught by Wash in order to save time and labor in inputting the photographic information of Takeuchi (answer, page 5).

Appellants argue that the “photographic information” on the film in Wash has nothing to do with information which is

recorded on a recording medium along with the image information. Specifically, appellants argue that the information on the film in Wash relates to controlling the photofinishing when developing and printing takes place which is completely different from the content information recorded in Takeuchi. Appellants also argue that there is no suggestion to combine the teachings of Takeuchi and Wash within the cited references, and that the examiner has used improper hindsight to justify the proposed rejection.

We agree with appellants. The coded information which accompanies the image in Wash relates to the automatic control of the photodeveloping process. The claimed invention is directed to a system which can both sense the photographed image on a film and read photographic information on the film and storing these two sources of information together on a recording medium. We agree with appellants that the coded film of Wash would not have suggested to the artisan that the system of Takeuchi be modified to read information from the film associated with the image for concurrent storage. The proposed modification of Takeuchi would require not only that the Takeuchi device be capable of handling a special type of

film, but would also require that a specific type of reading means be added to Takeuchi for reading and storing the coded photographic information. The Wash film is simply unrelated to the type of film necessary to form the system set forth in the claimed invention. Although the invention of claim 18 appears relatively broad and simple, we merely determine that the prior art applied by the examiner fails to support the modification proposed by the examiner to indicate obviousness.

Although independent claims 19 and 20 are of slightly different scope from claim 18, the examiner essentially relies on the same rationale for combining the teachings of Takeuchi and Wash (answer, pages 6-7). We again determine that the combination of references proposed by the examiner is not supported by the prior art. The rejection appears contrived for no other reason than to meet the claimed invention. Therefore, we do not sustain the rejection of independent claims 18-20 or of dependent claims 3-5, 7, 8, 10 and 12-14 based on the collective teachings of Takeuchi and Wash.

Although dependent claim 2 is rejected using the additional teachings of Ueno, Ueno does not overcome the deficiencies in the basic combination of Takeuchi and Wash

discussed above. Therefore, we also do not sustain the rejection of claim 2 based on the collective teachings of Takeuchi, Wash and Ueno.

We now consider the rejection of claims 9, 16, 17 and 21 based on the teachings of Takeuchi, Wash and Blancato. The deficiencies of the Takeuchi-Wash combination have been discussed above. We also agree with appellants that the image modifications taught by Blancato have absolutely nothing to do with a filing system as taught by Takeuchi, and there would be no motivation for the artisan to use the teachings of Blancato to modify the systems of Takeuchi or Wash. Therefore, we do not sustain the rejection of claims 9, 16, 17 and 21 based on the collective teachings of Takeuchi, Wash and Blancato.

In summary, we have not sustained any of the examiner's prior art rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 2-5, 7-10, 12-14 and 16-21 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

JS:hh

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